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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,508	09/21/1999	PAUL DAVID METCALFE	1749-258	4047

7590 11/17/2003

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EXAMINER

BOCHNA, DAVID

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/381,508

Applicant(s)

METCALFE, PAUL DAVID

Examiner

David E. Bochna

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-40 and 42 is/are rejected.
- 7) ☒ Claim(s) 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-29 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/22690.

In regard to claim 27, WO 98/22690 discloses an expandable connection between two slotted tubulars 18, 19 (fig. 3), the connection formed by co-joining the tubulars (via 16 which can be a solid sleeve (see page 4, line 10)) to form a connection region having non-overlapping slots, wherein the connection region includes ends 17 of the tubulars forming the connection.

In regard to claim 28, further including a connector portion 16 for receiving the tubular ends to provide two connection regions (region in the area of screws 21), one at each end of the connector having non-overlapping slots circumferentially disposed.

In regard to claim 29, WO 98/22690 discloses an expandable connection for wellbore tubulars comprising:

A first tubular 18 having a first connection member (whole for screw 21) on a first end thereof;

A second tubular 16 having a second connection member (whole for screw 21) on a second end thereof, the first and second connection members being inter-engageable; and

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A substantially cylindrical member 19 disposed adjacent the inter-engaged first and second connection members, wherein the substantially cylindrical member and the first and second connection members form a connection region having non-overlapping slots.

3. Claims 30-40 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/37681.

In regard to claim 30, WO 96/37681 discloses an expandable connection for expandable tubulars comprising:

an expandable tubular 24 or 22 having a first end 37 or 39 and a second end 35 or 34, the first end 37 or 39 having a first connection member 33 or 32;

a second connection member 32 or 33, the first and second connection members being inter-engageable along a first substantially cylindrical surface 27a or 27b; and

wherein the second end 35 or 34 is disposed adjacent a portion of the inter-engaged first and second connection members along a second substantially cylindrical surface (the surfaces of 35 and 39 or 37 and 34 are substantially cylindrical).

In regard to claim 31, at least one of the cylindrical surfaces 27b is a threaded surface 33.

In regard to claim 32, the second end 34 is disposed outwardly of the connection members 32, 33.

In regard to claim 33, the second end 35 is disposed inwardly of the connection members 32, 33.

In regard to claim 34, WO 96/37681 discloses an expandable connection for expandable tubulars comprising:

a first expandable tubular 24 having a first connection member 33;

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a second expandable tubular 22 having a second connection member 32, wherein the first and second connection members are inter-engageable along a first substantially cylindrical surface 27a; and

a third connection member 35 disposed adjacent a portion of the inter-engaged first and second connection members along a second substantially cylindrical surface (surfaces 35 and 39 are substantially cylindrical).

In regard to claim 35, at least one of the cylindrical surfaces 27a is a threaded surface 32.

In regard to claim 36, the second connection member 32 is disposed between the first 33 and third 35 connection members.

In regard to claim 37, the third connection member 35 is connected to the first tubular 24.

In regard to claim 38, the third connection member 35 is connected to the first tubular 24.

In regard to claim 39, the first 24 and second 22 expandable tubulars comprise expandable slotted tubulars.

In regard to claim 40, each slot comprises an overlapping portion and a non-overlapping portion.

In regard to claim 42, WO 96/37681 discloses a first expandable tubular 24 having a first connection member 35;

a second expandable tubular 22 having a second connection member 39, wherein a connection region is formed by engaging the first and second connection members; and

a cylindrical member 27b encircling at least a portion of the connection region.

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*Allowable Subject Matter*

4. Claim 41 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (703) 308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



David Bochna  
Primary Examiner  
Art Unit 3679  
November 14, 2003